

Atty Dkt. No.: 10010342-1
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REMARKS

The Examiner is respectfully requested to withdraw the rejections and allow Claims 3-10, 15, 33-52, the only claims pending and currently under examination in this application.

Claim 3 has been amended to specify that the at least one spacing element is positioned on the bottom surface and that the at least one spacing element adjusts the spacing between the at least one array and the bottom surface and the cover when the bottom surface and the cover are operatively associated. Support for these amendments may be found in the specification, e.g., at page 9, paragraph [0044]; page 10, paragraph [0018]; page 11, paragraph [0049]; "The at least one adjustable spacing element is capable of changing the spacing of between the array and chamber opposing surfaces when the array is present in the chamber..."; page 20, paragraph [0086]; and Figs. 1, 3, 4, 5 and 6.

Claims 16-32 have been canceled. The cancellation of claims is made without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Claims 37-52 have been added as new. Independent Claim 37 represents original Claim 11 which was objected to but indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Claim 12 has been amended to depend from new Claim 37. Independent Claim 45 represents original Claim 13 which was objected to but indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Claim 14 has been amended to depend from new Claim 45. Claims 38-41 have been added as new to depend from Claim 37 and Claims 46-52 have been added as new to depend from Claim 45. Support for these claims may be found in the specification and the originally filed claims.

Paragraphs [0079] and [0083] have been amended to correct typographical errors.

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As no new matter has been added by the above amendment, the Applicants respectfully request entry thereof.

REJECTION UNDER 35 U.S.C. § 102(b)

Claims 3-4 and 35-36 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Pay. The Applicants respectfully submit that Pay does not anticipate Claims 3-4 and 35-36.

Under current case law, a reference does not anticipate a claim unless "all of the elements and limitations of the claim are found within [that]...reference...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of invention." Scripps Clinic v. Genentech, Inc., 18 USPQ2d 1671, 1672 (Fed. Cir. 1992).

As described above, independent Claim 3, and the claims that depend therefrom, have been amended to specify that the at least adjustable spacing element is positioned on the bottom surface of the array hybridization chamber. Accordingly, in order for Pay to anticipate these claims, Pay must teach a hybridization chamber having at least one adjustable spacing element positioned on the bottom surface of a hybridization chamber.

However, Pay does not teach a hybridization chamber having a bottom surface with at least one adjustable spacing element positioned thereon, as claimed in the subject claims. Rather, Pay teaches an assembly 10 for in vitro culture of cells. Specifically, the assembly of Pay includes a culture vessel 12 with at least one well 14 having an open top 16, a bottom 18, and a wall 20 with an inside surface 22. Assembly 10 also includes an insert 24 for placement within well 14 and which has a membrane 34 (col. 3, lines 7-23 and FIG. 1). The Examiner refers to means 70 and 74 of FIG. 3 for adjusting the positioning of the membrane with respect to the chamber bottom (similar components of FIG. 3 are numbered similarly to those of FIG. 1 using a suffix "a" to identify the components of FIG. 3). However, outward projections 70 are positioned on insert 24a and steps 74 are positioned in inside surface 22a of well 14a. In other words, neither of these components are positional on bottom 18a.

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Accordingly, for at least this reason, Pay does not anticipate claims 3-4 and 35-36. As such, the Applicants respectfully request that this rejection be withdrawn.

Claims 3-4, 6, 15 and 33-36 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Jones et al. The Applicants respectfully submit that does not anticipate Claims 3-4, 6, 15 and 33-36.

Independent Claim 3 has been amended to specify that the at least one adjustable spacing element adjusts the spacing between an array and an operatively associated bottom surface and cover of the hybridization chamber. In other words, the chamber includes at least one spacing element that is configured to adjust the spacing between an array and the bottom surface of the chamber and the cover of the chamber. Accordingly, in order for Jones et al. to anticipate these claims, Jones et al. must teach a hybridization chamber having at least one adjustable spacing element for adjusting the spacing between an array and (1) a bottom surface of the hybridization chamber, and (2) a cover of the hybridization chamber.

Jones et al. do not teach a hybridization as claimed in the subject claims. Specifically, Jones et al. teach an automated immunoassay cassette 10 having a base 12, a reagent support 14 having an analyte detection zone 34 and adjustable side members 16. The Examiner asserts that Adjustable side members 16 adjust the position of detection zone 34 relative to base 12. However, Jones et al. do not teach that adjustable side members 16 adjust the spacing between the reagent support 14 and the detection zone 34, as reagent support member 14 contains the analyte detection zone (see for example Figs. 1-4 and col. 4, lines 49-52). In other words, the spacing between the detection zone and the reagent support member is not adjusted by the adjustable side members or by any other analogous structure as the detection zone and the reagent support member remain in intimate contact, as shown for example in figures of this reference which illustrate the various positions of the components of the cassette when in use.

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Accordingly, for at least this reason, Jones et al. do not anticipate 3-4, 6, 15 and 33-36. As such, the Applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §103

Claims 5, 7-10, 15, 33 and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Pay in view of Mahe. The Applicant respectfully submit that Claims 5, 7-10, 15, 33 and 34 are patentable under 35 U.S. C. §103(a) over Pay.

The M.P.E.P. provides clear guidance on the requirements of a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.**" M.P.E.P. § 2142.

Thus, the cited reference or combination of references must teach or suggest all of the limitations of the claimed invention for the claimed invention to be rendered obvious over the reference. Each of the subject claims specifies at least adjustable spacing element positioned on the bottom surface of an array hybridization chamber.

As described above, Pay fails to teach at least adjustable spacing element positioned on the bottom surface of the array hybridization chamber. Pay also fails to suggest such a hybridization chamber as Pay explicitly teaches that outward projections 70 are positioned on insert 24a and steps 74 are positioned in inside surface 22a of well 14a and Pay does not teach or even suggest any adjustable spacing elements on bottom 18. Mahe et al. is cited solely for teaching an incubator with temperature control and agitation for growing cells and thus fail to make-up for the deficiencies of Pay as Mahe et al.

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do not teach or even suggest at least one adjustable spacing element of any kind, let alone at least one adjustable spacing element as claimed in the subject claims.

Furthermore, Claim 8 specifies at least one mixing element chosen from the group of: at least one resistor, ultrasonic element, recirculation pump, at least one roller, at least one adjustable spacing element and at least one solenoid. However, Mahe et al. do not teach or suggest a mixing element as claimed in Claim 8. In fact, Mahe et al. merely teach an agitation motor (col. 2, line 65) and that "... the support plate 104 is designed for orbital movement as is known in the art of incubator shakers. Thus, at the appropriate time, the apparatus activates the drive motor in base section 16, this causing the shaker plate to shake its pre-designed motion." (col. 6, lines 31-36; see also col. 4, lines 23-26 describing the plate's orbital motion). Accordingly, Mahe et al. do not teach a mixing element as claimed in Claim 8.

For at least the reasons described above, Claims 5, 7-10, 15, 33 and 34 are patentable over Pay in view of Mahe et al. As such, the Applicants respectfully request that this rejection be withdrawn.

OBJECTIONS

Claims 11-14 have been objected to but indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. The Applicants thank the Examiner for the indication of allowance of these claims. Accordingly, independent Claim 11 has been rewritten as new Claim 37 and includes all the limitations of the base claim and any intervening claims and independent Claim 13 has been rewritten as new Claim 45 and includes all the limitations of the base claim and any intervening claims. The Applicants respectfully submit that these claims are now in condition for allowance as they represent the independent form of the objected to claims and include all the limitations of the base claim and any intervening claims.

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CONCLUSION

The applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at (650) 327-3400.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 which may be required by this paper, or to credit any overpayment, and authorize the Commissioner to charge our Deposit Account No. 50-1078, Order Number 10010342-1, for any fees due in connection with the filing of this document.

Respectfully submitted,

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